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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/741,536	12/19/2003	Kent D. Vincent	200314650-1	5132

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT PAPER NUMBER

1713

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/741,536

Applicant(s)

VINCENT ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 and 42-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-35, 40, 42, 44 and 48-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-39, 43 and 45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims 1-35, 40, 42, 44 and 48-65, drawn to inventions nonelected with traverse in Paper No. 031005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

2. Due to amendments and persuasive arguments by applicant, the previous rejections of record based on Handa et al., Patel et al. or Johnson et al. have been overcome and are hereby withdrawn.

Claim Rejections - 35 USC § 102/103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 36-39, 43, 45 and 46 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Ohta et al., for reasons cited in previous Office actions.

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5. Claims 36-39, 43 and 45-47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Nichols et al., for reasons cited in previous Office actions.

Response to Arguments

6. Applicant's arguments filed 07/24/2006 have been fully considered but they are not persuasive.

7. Applicants arguments center on their belief/understanding that the released "blocking groups" from the recited process for preparing the claimed "acidified latex particles" are present in the ink as claimed. Applicant is reminded that the presently claimed ink comprises three essential things: a liquid vehicle, a colorant and latex particles. Even if the particles are prepared in a prior process wherein "blocking groups" are released in the liquids phase used for preparing the particles, there is still nothing in the claims requiring the "blocking groups" to be included in the ink along with the presently claimed particles.

The section in the specification where applicants point for evidence that the same "liquids phase" used in preparing the latex particles is used or necessarily present in or is the claimed "liquid vehicle" only recite optimal embodiments wherein a "**typical** liquid vehicle formulation that **can** be used with the latexes described herein **can** include water, and **optionally**, one or more co-solvents present in total at from 0 wt% to 30 wt%", and that the "[t]**ypically**, the ink vehicle is **predominantly** water", wherein "the

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liquid phase of the latex dispersion **can** be admixed with liquid vehicle components to form the liquid vehicle, or the liquid phase **can** become the liquid vehicle upon addition of colorants. (emphasis added)".

The requirement that the liquid phase used to prepare the particles must be that same liquid vehicle of the ink is simply **not** claimed in the presently rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant has failed to demonstrate that the recited process inherently yields a unique product as the elements being focused on by applicant (i.e., the preparatory phase for the latex and the "blocking groups) are not present in the ink as presently claimed.

8. Regarding Ohta et al. and the two embodiments taught therein, contrary to applicant's conclusions, a copolymer consistent in structure with a grafted copolymer can also be produced by direct copolymerization, depending on the comonomers used. There is no inherent structure in the grafted latex particles that cannot be arrived at by careful selection and copolymerization of the right monomers. The grafting does not necessarily result in a deviation from applicant's latexes particles, especially considered that applicant's only structural limitation for the acid monomers is that they ultimately contain, somewhere in their molecule, one of the recited strong acid groups.

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As for the second embodiment in Ohta et al., applicant's argument is directed to the stability and therefore ease of preparation of the latex particles. There is still no evidence of any actual structural difference between what applicant is actually claiming, the particle in a liquid vehicle with colorant, and what the prior art has taught. Applicant may have a new and improved process of production, but this is not evidence of a unique product.

9. Regarding Nichols, as stated above, even if the particles are prepared in a prior process wherein "blocking groups" are released in the liquids phase used for preparing the particles, there is still nothing in the claims requiring the same liquids phase for preliminary particles in the ink nor the released "blocking groups" contained therein after de-blocking.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER
KCE

